



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,979	09/17/2003	Daniel M. Marks	110293.133US1	1953
61302 7590 02/27/2008 PTT LLC (D/B/A HIGH 5 GAMES) 1200 MACARTHUR BLVD MAHWAH, NJ 07430				
EXAMINER THOMASSON, MEAGAN J				
ART UNIT		PAPER NUMBER		
3714				
MAIL DATE		DELIVERY MODE		
02/27/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/663,979

**Applicant(s)**

MARKS ET AL.

**Examiner**

MEAGAN THOMASSON

**Art Unit**

3714

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29, 30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29, 30 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 5, 2007 has been entered.

### ***Response to Amendment***

The examiner acknowledges the cancellation of claims 31 and 33. Claims 29,30 and 32 are pending in this application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3714

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benett (US 6,585,264 B2) in view of Locke (US 2003/0022712).

Benett discloses an electronic gaming device and method wherein a player places a wager, a plurality of symbols are arranged and displayed, including wildcard symbols, wherein said wildcard symbols are expandable in a plurality of directions. The player is then awarded based on various symbol combinations. The direction of the wildcard symbol expansion may be upwards, downwards, leftwards, rightwards or diagonally from the symbol position in which the wildcard symbol appears (see Figs. 3-8). Each of the symbols has a predetermined movement pattern that is determined, i.e. assigned by, the indicia displayed on the wildcard symbol (col. 1, lines 62-65). For example, a "Bishop" piece may only move in a diagonal direction, as governed by the fact that it is a "Bishop". Upon completion of the symbol expansion process, a player may then be awarded a prize for obtaining a winning symbol combination (col. 2, lines 30-32).

Column 3, lines 43-51, describe the gaming method as upon the occurrence of a wildcard symbol, referred to by Benett as a chess symbol, the wildcard symbol will "make one move, i.e. from its initial position to a following display position, according to its normal chess movement pattern. If there is more than one direction in which such a move can be made, then, initially, one direction of movement is randomly selected by the controller 44 of the gaming machine 10. As the chess piece moves to each position

in its pattern, it being understood that there is an underlying symbol at each such position, it changes the underlying symbol to that chess piece. When it has completed its move, all wins will be paid in which one or more of the chess pieces substitutes".

Additionally, Benett discloses automatically expanding wildcard symbols as stated in col. 3, lines 40-44, wherein "whenever any chess piece substitute symbol is spun up and displayed ... the chess piece will make one move, i.e. from its initial display position to a following display positions". That is, whenever a piece is displayed it will automatically expand, i.e. the wildcard symbol will expand without evaluating anything except whether or not a wildcard symbol is present.

Further, Benett discloses always replacing the symbols in col. 2, lines 15-19, wherein "When the chess piece moves according to its movement pattern it may require any standard symbol is a display position in the movement pattern of the chess piece to which the chess piece moves and may act as a substitute for such standard symbol", as well as in col. 3, lines 47-50, wherein "As the chess piece moves to each position in its pattern, it being understood that there is an underlying symbol at each such position, it changes the underlying symbol to that chess piece".

*Benett does not specifically disclose automatically expanding wildcard symbols, if displayed in the symbol matrix, in all of the predetermined directions assigned by the directional indicia displayed on each said wildcard symbol. Specifically, Benett discloses that if there is more than one possible direction of movement associated with a wildcard, then the direction of movement is selected by the controller (col. 3, lines 44-47). However, in an analogous slot machine gaming device, Locke discloses the use of*

wildcard symbols that move to occupy other symbol spaces, i.e. expand from the original symbol space on which the wildcard symbol appears, such that “the appearance of the symbol itself may be modified such that movement of the symbol is consistent with the type of symbol being moved” (§0027). That is, the direction of movement of the symbol is assigned by the directional indicia displayed on each said wildcard symbol. Further, Locke discloses an embodiment of the invention wherein the symbol expands in all of the predetermined directions as assigned by the directional indicia, as shown in Fig. 7-9. In this embodiment, the balloon wildcard symbol may only move in an upward direction, as governed by the wildcard indicia itself. Because the balloon may only move upward and does so, as shown in Fig. 7-9, the balloon wildcard symbol expands in all of the predetermined directions assigned by the directional indicia.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the symbol expansion slot machine game of Benett with the symbol expansion slot machine game of Locke in order to produce a slot machine game having expandable wildcard indicia such that the wildcard indicia automatically expands in all of the predetermined directions assigned by the directional indicia displayed on each said wildcard symbol as the slot machine games are analogous inventions in the same field of endeavor. Both games endeavor to provide exciting new features for slot machine games, as disclosed by Benett (col. 1, lines 13-28) and Locke (§ 0002-0003). Further, all of the claimed components were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in

their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Regarding claim 30, the directional indicia for a wildcard symbol assigns one or more of the following predetermined directions upwards, downwards, leftwards, rightwards, and diagonally, as disclosed by Benett (Fig. 3-8) and Locke (¶0027).

Regarding the limitation of claim 31, wherein the method described above further comprises a wildcard symbol expands N symbol position, from the symbol position in which the wildcard symbol appears towards the predetermined direction(s) assigned to the wildcard symbol, with N calculated in one of the following manners; N is a fixed number, N is a random number, or N is a random number selected from a range of numbers, Benett discloses that the number of symbols positions that the wildcard symbol expands into may be a fixed number (col. 4, lines 22-45).

Regarding claim 32, Benett discloses the use of words as directional indicia displayed on the wildcard symbol (Fig. 3-8). The word "Bishop" substantially meets the broadest reasonable definition of the term "directional indicia", as the word Bishop indicates the diagonal direction in which the piece must move.

### ***Response to Arguments***

Applicant's arguments, see Remarks P. 4, filed December 25, 2007, with respect to the 35 U.S.C. 112, first paragraph, rejection of claims 31 and 33 have been fully considered and are persuasive. Applicant's cancellation of claims 31 and 33 renders the rejection moot, and thus the rejection of claims 31 and 33 has been withdrawn.

Applicant's arguments filed December 25, 2007 have been fully considered but they are not persuasive.

Specifically, applicant's arguments that the roaming symbol feature game disclosed by Locke does not meet the limitation of "automatically expanding wildcard symbols, if displayed in the symbol matrix, in all of the predetermined directions assigned by the directional indicia displayed on each said wildcard symbol", as recited in claim 29, as the symbol taught by Locke a) is not a "wildcard symbol", b) does not expand from its original position into other positions, nor c) assign a direction of expansion to the wildcard symbol (Remarks, P. 7). The examiner respectfully disagrees for the following reasons.

Firstly, the symbols disclosed by Locke, specifically the balloon symbol of the embodiment displayed in Fig. 6-9, may be considered a "wildcard symbol" in the broadest reasonable interpretation of the term in that the balloon symbols provide an additional award to a player. That is, once the slot machine reels have stopped spinning and the resulting symbol matrix is displayed, the player may receive an additional award for the appearance of any balloon symbols in the matrix regardless of the base game payout values associated with a symbol combination appearing on a payline (§10023-0025). Thus, the balloon symbols act as wildcard symbols by providing an award that the player may not have received had the balloon symbols not appeared in the symbol matrix.

Secondly, the balloon symbol disclosed by Locke expands from its original position into other positions as it first provides an award in the form of a multiplier value



in the original symbol position, moves into an adjacent symbol position and provides an additional award and continues this movement pattern until the balloon symbol reaches the top of the screen (Fig. 6-9, ¶0023-0024). Locke specifically discloses that “a BALLOON symbol such as the symbol **68** in Fig. 7-9 starting from a bottom symbol position on reel **32** would yield a final multiplier of 5x as it progressively rises from the bottom symbol position worth 1x, through the middle symbol position worth an additional 2x, and to the top symbol position worth an additional 2x” (¶0024). This progressive movement from one symbol position to the next sufficiently meets the definition of symbol “expansion”, as the balloon symbol expands to increase the number of spaces that it occupies or has occupied.

Finally, Locke specifically discloses the direction of expansion is assigned by indicia displayed on the wildcard symbol in ¶0027, wherein “The appearance of the symbol itself may be modified such that movement of the symbol is consistent with the type of symbol being moved”. Further, the limitation of symbol indicia determining the direction of expansion of the symbol is additionally met by Benett, as described in the above rejection.

In light of at least the passages of Locke cited in the above arguments, the examiner finds applicant's arguments not persuasive and maintains the previous rejection of claims 29,30 and 32 as being unpatentable over Benett in view of Locke.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MEAGAN THOMASSON whose telephone number is (571)272-2080. The examiner can normally be reached on M-F 830-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Meagan Thomasson  
February 19, 2008  
/XUAN M. THAI/  
Supervisory Patent Examiner, Art Unit 3714